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OFFICE OF PETITIONS

In re Application of: : ON PETITION
Arita :
Filed: 1 June, 2001 :
Application No. 09/871,149 :
Docket No.: 82084-002 :

This is a decision on the petitions filed herein on 2 May, 2003, under 37 C.F.R. §1.137(a)¹ to revive the above-identified application, and, in light of the allegations, considered as a request to withdraw the holding of abandonment under 37 C.F.R. §1.181.²

¹ A Petition filed under the provisions of 37 C.F.R. §1.137(a) must be accompanied by:

(1) The required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application for patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;
(2) the petition fee required by 37 C.F.R. §1.17(l);
(3) A showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the reply due date until the filing of a grantable petition pursuant to the is paragraph was unavoidable; and
(4) Any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c).

An application is "unavoidably" abandoned only where Petitioner (or Petitioner's counsel) takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, the response is not timely received in the Office. That is, in the context of ordinary human affairs the test is such care as is generally used and observed by prudent and careful persons in relation to their most important business. *Ex parte Pratt*, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887); *Ex parte Henrich*, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

² The regulations at 37 C.F.R. §1.181 provide, in pertinent part:

§1.181 Petition to the Commissioner.

(a) Petition may be taken to the Commissioner: (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court; (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. * * *

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Brief or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declaration (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, it may be required that there have been a proper request for reconsideration (§1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his decision upon the matters averred in the petition, supplying a copy thereof to the petitioner.

(d) Where a fee is required for a petition to the Commissioner the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed. * * *

For the reasons set forth below, the petition under 37 C.F.R.:

- §1.137(a) is **DISMISSED**; and
- §1.181 is **DISMISSED**.

NOTES:

- (1) Any petition (and fee) for reconsideration of this decision under 37 C.F.R. §1.137(a) (as to unavoidable delay) or an alternative request for relief under 37 C.F.R. §1.137(b)³ (as to unintentional delay) must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.137(a)"; and/or "Petition under 37 C.F.R. §1.137(b)";
- (2) Thereafter, there will be no further reconsideration of this matter.

BACKGROUND

The record indicates that:

- Petitioner Stephen B. Parker (Reg. No. 36,631) (Petitioner) failed to reply timely and properly to the Notice to File Missing Parts (fees and oath/declaration with surcharge) mailed by the Office to Petitioner's former office Hogan and Hartson (Hogan) on 31 July, 2001, with reply due (absent extension of time) on or before Monday 1 October, 2001;

(f) Except as otherwise provided in these rules, any such petition not filed within 2 months from the action complained of, may be dismissed as untimely. The mere filing of a petition will not stay the period for reply to an Examiner's action which may be running against an application, nor act as a stay of other proceedings. * * * (Emphasis supplied.)

³ Effective December 1, 1997, the provisions of 37 C.F.R. §1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 C.F.R. §1.137(b). a grantable petition filed under the provisions of 37 C.F.R. §1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.
(2) the petition fee as set forth in 37 C.F.R. §1.17(m);
(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and
(4) any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c). (Emphasis supplied.)

- the application was deemed abandoned after midnight 1 October, 2001;
- Petitioner filed a Notice of Change of Correspondence address (from Hogan to Rothwell, Figg Ernst & Manbeck (Rothwell)) on 5 December 2002, and the Office acknowledged that filing on 10 March, 2003;
- Notice of Abandonment was mailed on 14 April, 2003;
- Petitioner:
 - states that “[Hogan] is a large firm with multiple thousands of employees and more than 18 offices world wide”;
 - indicates that no Notice was received at the Hogan firm and, while, “there is some likelihood that this Notice was inadvertently not mailed by the Patent Office . . . [t]here is also some likelihood that this Notice was inadvertently mis-handled by the [Hogan] mail center and not properly routed to the docketing department”;
 - supplies a one- (1-) page docketing sheet from Hogan evidencing no listing of the Notice to File Missing Parts;
 - acknowledges that “[Hogan’s] mail room processes a large volume of mail that may, in some instances, be mishandled”;
 - contrasts the Hogan system with those at Rothwell, which has “many years of operation as a strong mid-sized Patent Boutique”;
 - claims that, “[n]otably, in a recent Patent Office Business Method Partnership Meeting held at the Patent Office, the Patent Office indicated that the first Office Actions are usually not received for **well over two years** in this class . . . [and] . . . [r]ecently, the Patent Office even confirmed that this is now often **well over three years** until the first Office Action in this class” (emphasis, the original); and
- notably:
 - in the nearly two years of pendency between filing of the application and the filing of the instant petition, Petitioner has filed not one Status Inquiry in this matter; and
 - with the instant petition Petitioner failed to file a reply to the Notice of Missing Parts (filing fees, oath/declaration and surcharge)--Petitioner is cautioned that there have been changes in fee structure since the mailing of the Notice, and the

fees quoted in that 2001 Notice are not the current fees, which schedule may be found at the Office website: www.uspto.gov).

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).⁴

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.⁵

Delays in responding properly raise the question whether delays are unavoidable.⁶ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁷

And the Petitioner must be diligent in attending to the matter.⁸ Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and

⁴ 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

⁵ Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

⁶ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

⁷ See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁸ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office *supra*.

regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁹⁾

Allegations as to the Request to Withdraw
the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.¹⁰

Petitioner makes no showing that the Office caused the delay which triggered abandonment of the instant application. Therefore, withdrawal of the holding of abandonment is wholly inappropriate.

Allegations as to Unavoidable Delay

In determining if a delay was unavoidable, decisions on reviving abandoned applications have adopted the standard of the reasonably prudent person acting in their most important business matters.¹¹ In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account."¹²

Petitioner acknowledges that the delay might have resulted in the mis-handling of the Notice by his former office and he cannot demonstrate (or at least fails to do so) error on the part of the Office. Such performance does not rise to the Pratt standard.

Petitioner also alludes to statements allegedly made by the Office. Petitioner is reminded that practice before the Office is not an oral process. (See: 37 C.F.R. §1.2¹³) Moreover, diligent practice would prompt one to inquire when one claims to have received no reply from the Office in nearly two (2) years--for example, a Status Inquiry at six- (6-) month intervals would be a prudent practice by which one might demonstrate diligence as foreseen in the Pratt standard.

⁹ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

¹⁰ See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

¹¹ Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

¹² Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

¹³ The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.
All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

Three periods to be considered during the evaluation of a petition under 37 C.F.R. §1.137 are the delay in:

- (1) reply that originally resulted in abandonment and from the abandonment until discovery thereof;
- (2) filing an initial petition pursuant to §1.137 to revive the application; and
- (3) filing a *grantable* petition¹⁴ pursuant to §1.137 to revive the application.¹⁵

This petition fails to make the required showing as to all three periods that the delay was unintentional within the meaning of 35 U.S.C. §§133 and 41(a)(7) and 37 C.F.R. §1.137.

Petitioner must satisfactorily address this issue in any request for reconsideration.

Petitioner's most limited submission of documentation in satisfaction of a showing as required under 37 C.F.R. §1.137:

- but a single docket sheet for the application, with no mail logs or docket report for the due date of the reply evidencing that a transaction that should have been docketed wasn't; and
- not a copy of correspondence, memoranda, personal calendars or desk journals.

Accordingly, in view of the failure of the "showing" requirement to be met herein, the petition to revive as to unavoidable delay under 37 C.F.R. §1.137(a) cannot be granted.

CONCLUSION

Because Petitioner failed to satisfy the burdens set forth in Delgar v. Schulyer, the petition under 37 C.F.R. §1.181 must be and hereby is dismissed.

Moreover, because Petitioner failed to satisfy the to the Pratt standard, the petition herein 37 C.F.R. §1.137(a) must be dismissed.

¹⁴ Because the 2 May, 2002, was and is not grantable, this period continues to run until such time as a grantable petition is filed.

¹⁵ See: Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131 at 53158 (10 October, 1997).

ALTERNATIVE VENUE

If Petitioner is unable to make a showing of unavoidable delay surpassing that tendered heretofore, Petitioner's only alternative to irretrievable abandonment is to file a petition and fee as set forth at NOTE 1, above at pages 1 and 2, under 37 C.F.R. §1.137(b), and state therein that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional."

Thus, Petitioner may wish to supplement his petition to plead alternatively under 37 C.F.R. §1.137(b) wherein the "showing" burden is much less onerous.

Petitioner is cautioned that failure to submit such a petition 37 C.F.R. §1.137(b) timely may be viewed as intentional delay and an absolute bar to revival.

Further correspondence with respect to this matter should be addressed as follows:

By mail: (Effective 1 May, 2003)¹⁶
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (703) 308-6916
ATTN.: Office of Petitions

By hand: Crystal Plaza Four, Suite CP4-3C23
2201 South Clark Place
Arlington, VA 22202

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.


John J. Gillon, Jr.
Senior Attorney
Office of Petitions

¹⁶ To determine the appropriate addresses for other subject-specific correspondence, refer to the USPTO Web site at www.uspto.gov.